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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,730	06/12/2001	Kenji Nagoya	B422-161	4879
26272	7590	09/13/2006	EXAMINER	
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/879,730

Applicant(s)

NAGOYA ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) 32-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment received on 6/27/2006 is acknowledged and entered. The applicant has canceled all the previously filed claims 1-23 and added new claims 24-43. Currently claims 24-43 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments (see Remarks, pages 7-11) have been considered but are moot in view of the new ground(s) of rejection necessitated due to new limitations added in the new claims.

This is a Final rejection.

### ***Election by Original Presentation***

3. The reply filed on 6/27/2006 is not fully responsive to the prior Office Action because newly submitted independent claims 32 and 37 and their dependencies 33-36 and 38-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly submitted independent claims 32 and 37 recite new limitations, that is ***means and step for generating a job file including printing condition when printing data is printed by the command from an application program, the printing condition including information of both sides printing, layout in a sheet and a***

***number of pages of the printing data and means and step for converting printing data from the application program into other printing data recognizable by said another apparatus*** (see currently added independent claims , 32 and 37) have a different and distinct utility than the earlier claimed invention. The different and distinct utility is generating a job file including printing condition when printing data is printed by the command from an application program, the printing condition including information of both sides printing, layout in a sheet and a number of pages of the printing data and converting printing data from the application program into other printing data recognizable by said another apparatus which was not required by the earlier filed invention/claims and is also argued separately by the applicant (see Remarks filed on 6/27/2006 in which the applicant has argued independent claims 24 and 28 differently from the claims 32 and 37 because the relate to distinct and different inventions) which was not required by the originally filed invention.

The applicant has already elected an invention via originally filed claims, but canceled now, and newly added claims 24-31 directed to an apparatus and storage medium having a computer executable program to create setting information to print data recognizable by other apparatus, to calculate a print charge before the print data is sent to the network (see earlier filed independent claims 1,12 and 23). The already elected invention is different and distinct from the claims 32 and 37 filed on 6/27/2006 for reasons given above. Therefore the newly added claims 32-43 are distinct and divergent from the earlier claimed inventions and would require a new, divergent and different search. Such change in the inventions amount to a " Shift claiming another

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invention after an election is once made and action given on the elected subject matter and are therefore subject to "Election by Original Presentation", as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

### **819 Office Generally Does Not Permit Shift:**

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. **Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right).** When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03** .....Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

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### **821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

#### **821.03 Claims for Different Invention Added After an Office Action**

Claims added by amendment following action by the examiner, **MPEP § 818.01** .....

#### **37 CFR 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143**

#### **¶ 8.04 Election by Original Presentation.....**

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**An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.**

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted 32-43 claims are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Since newly added claims 24-31 are readable on the elected invention they would be currently examiner in this application.

#### ***Claim Rejections - 35 USC § 112***

4.1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, user had possession of the claimed invention. In the currently added new claims 24-31 the applicant has included the limitation, "determining means for determining whether or not a printing charge is notified to a user by executing the application program",

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, user had possession of the claimed invention. The applicant's specification (see paragraph 0078 of the printed publication 2001/0056406 of the applicant's application) explicitly states that determination is made as *whether charge information is to be notified to the user*. The specification does not disclose determining if a printing charge is notified to a user. The two statements, one which is recited in the claim and the other disclosed in the applicant's specification are not same. Therefore, as best interpreted by the examiner based on the applicant's disclosure this limitation will be further treated on merits, as--- determining means for determining whether or not a printing charge is **to be notified** to a user by executing the application program---

4.2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 28 recite a conditional limitation. It is unclear to the Examiner what the scope of claims 24 and 28 is when the conditional statement is not true. For example, claim 24 recites the conditional limitation that the notification steps, all first, second and third would be required only if a determination is made to notify the printing charge to the user. The scope and breadth of the claim is indefinite in the event the

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determination step does not require notifying the printing charges to the user. For examination purposes, the conditional statements are not true and render the invention indefinite because one of ordinary skill in the art would recognize that when the condition event does not happen then the subsequent steps depending upon that conditional event would not take place and such a scenario or a possible outcome is reasonably supported by the Applicant's disclosure. A similar analysis applies to all dependent claims of claim 24 and claims 28-31.

### ***Objection to Specification***

5. The amendment filed on 1/3/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: " determining means for determining whether or not a printing charge is notified to a user by executing the application program" , which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, user had possession of the claimed invention. The applicant's specification (see paragraph 0078 of the printed publication 2001/0056406 of the applicant's application) explicitly states that determination is made as *whether charge information is to be notified to the user*. The specification does not disclose determining if a printing charge is notified to a user. The two statements, one which is recited in the



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claim and the other disclosed in the applicant's specification are not same. Therefore, as best interpreted by the examiner based on the applicant's disclosure this limitation will be further treated on merits, as— determining means for determining whether or not a printing charge is **to be notified** to a user by executing the application program---

Applicant is required to cancel the new matter in the reply to this Office Action.

6. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 24-31 are rejected under 35 U.S.C. 103(a) as being obvious over Yamaguchi (US Patent 6,385,675) and further in view of Arledge, Jr. et al. (US Patent 6,535,294), hereinafter referred to as Arledge.

Note: Claims 24-31 are being rejected in light of 35 USC 112, first paragraph rejection above.

7.1. Regarding claim 24, Yamaguchi discloses an information processing apparatus capable of printing data by using another apparatus connected to a network (see at least FIGs. 1-2 and 4 and col. 2, line 15-col. 4, line 67. The image processor 101 combined with the host computer 100 corresponds to the information processing apparatus using another apparatus 100 the copying machine to print data via a network.), comprising:

a memory for storing an application program and a printing module to be executed by said information processing apparatus, the printing module being different from the application program (see at least Figs 1-2, 4. The host computer 100 includes the storage memory for the application program and a printing module to be executed by the information processing apparatus (100 and 101), the printing module, that is the printing software being different from the application program required to print the output in the copying machine).

Yamaguchi discloses both aspects, that is instructing the other apparatus, that is the digital copying machine 100 to carry out the printing/copying (see col. 4, lines 10-13) without having to notify the user of the charges and also notifying the user of the

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charges before carrying out the printing/copying operation (see at least col.4, lines 42-50). Yamaguchi also discloses that the discriminator 101 G determines if there are any restrictions to printing before implementing the printing/copying operation (see at least col.4, lines 42-50) but does not disclose that those restrictions relate to determining if the printing charge is to be notified to the user. However, Arledge, in the same field of endeavor, that is ordering printing jobs online, discloses placing repeat orders for customized print jobs (see at least col.4, lines 20-34 , where Arledge discloses that a confirmation and acceptance is sought for the print job and its charges and col.19, lines 1-13 where Arledge shows placing duplicate orders online for a predetermined customized print job) and it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention that this condition of placing repeat orders of customized orders online would warrant a condition if the repeat orders can be accepted at the old price or at a new price and if it has to be a new price then the determination would be made to notify the user of new price for his acceptance and confirmation and if there is no price change then the determination would be made to not to notify the user but instead execute the order. In view of the disclosure of Arledge of placing duplicate orders for customized print jobs online, it would be obvious to one of an ordinary skilled in the art to modify Yamaguchi to determine, in case of repeat orders, if the repeat order can be accepted at the old price or at a new price and if it has to be a new price then the determination would be made to notify the user of new price for his confirmation and acceptance and if there is no price change then the determination would be made to not to notify the user but instead execute the order. If

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the user does not accept the new/changed price for the duplicate order he can convey his refusal or offer a lower price and which would result in canceling the printing operation. The motivation to include the determination step is suggested in Yamaguchi itself (see col.4, lines 52-67) to know the charges beforehand to avoid budget problems or to avoid charges exceeding the upper limit of the user .

In case if the determination is made to notify the user then Yamaguchi discloses first notification means for notifying print job details which can include the number of logical pages to be printed to the printing module by an application program (see at least col.3, lines 9-21 and col.4, lines 42-50 and Figs 1-5). In Yamaguchi all the operations are being done by a computer hence an application program informs the accounting operation, which is the part of the print module the job details to calculate a printing/copying charge) and carries out the calculation of the printing charge based on the print job parameters which can include a number of output total pages according to a printing condition, notifying the printing charge calculated to the user via an application program (see at least col.3, lines 9-21 and col.4, lines 42-50 and Figs. 1-5) and then finally notifying [ the third notification means] for instructing the other apparatus, that the is the copying machine to print the print job.

Regarding claim 25, Yamaguchi discloses that the calculating of the printing charge is done based upon the print job parameters, such as number of pages, kind of paper, etc, and it would be obvious to one of an ordinary skilled in the art that such parameters can include printing a number of papers in one output page.

Regarding claim 26, Yamaguchi in view of Arledge (see the analysis presented in rejecting claim 24 above) discloses/suggests that a printing charge is not notified or printing is executed after the user confirms the printing charge and/or printing is canceled after the user confirms the printing charge. Arledge, in the same field of endeavor, that is ordering printing jobs online, discloses placing repeat orders for customized print jobs (see at least col.4, lines 20-34 , where Arledge discloses that a confirmation and acceptance is sought for the print job and its charges and col.19, lines 1-13 where Arledge shows placing duplicate orders online for a predetermined customized print job) and it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention that this condition of placing repeat orders of customized orders online would warrant a condition if the repeat orders can be accepted at the old price or at a new price and if it has to be a new price then the determination would be made to notify the user of new price for his acceptance and confirmation and if there is no price change then the determination would be made to not to notify the user but instead execute the order. In view of the disclosure of Arledge of placing duplicate orders for customized print jobs online, it would be obvious to one of an ordinary skilled in the art to modify Yamaguchi to determine, in case of repeat orders, if the repeat order can be accepted at the old price or at a new price and if it has to be a new price then the determination would be made to notify the user of new price for his confirmation and acceptance and if there is no price change then the determination would be made to not to notify the user but instead execute the order. If

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the user does not accept the new/changed price for the duplicate order he can convey his refusal or offer a lower price and which would result in canceling the printing operation.

Regarding claim 27, Yamaguchi discloses switching between calculating of printing charge and printing according to command from the application program (see at least (see at least col.3, lines 9-21 and col.5, lines 30-67 which show that the accounting operation, part of the print module calculates and then after receiving confirmation the application program, part of the print module, executes the printing operation. Note: The printing module, as best understood by the examiner based upon the applicant's disclosure is a software stored in the memory to execute certain instructions related to calculating and carrying out printing operation.).

7.2. Regarding claims 28-31, their limitations are closely parallel to the limitations of claims 24-27 and are therefore analyzed and rejected on the same basis.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

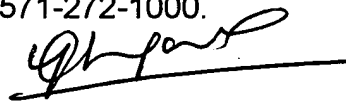
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
9/7/2006